

**REMARKS**

Claims 4, 5, 8, 10-12, 16, 17 and 20-22 are pending in the application.  
Claims 4, 5, 8, 10-12, 16, 17 and 20-22 had been rejected.  
Claims 21 and 22 have been amended.  
No new matter has been added.  
Reconsideration of the Claims is respectfully requested.

**1. Rejection under 35 U.S.C. § 112, ¶ 1**

Claims 8, 21 and 22 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991), “to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.” MPEP § 2163.02 at page 2100-167 (citations omitted). Further, the subject matter of the claim “need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” *Id.*

In rebuttal, Applicant respectfully submits that each claim limitation is “expressly, implicitly, or inherently supported in its originally filed disclosure.” MPEP § 2163.05 at page 2100-169.

With respect to Independent Claim 8, Applicant respectfully points out that this claim was filed with the instant application, and has been minimally amended in view of objections in an earlier Office Action.

For Independent Claim 8, the Office Action pointed to the language of “repeating the terminating of the weakest soft handoff link for at least some of the plurality of serviced mobile terminals.” (Office Action at p. 2). In support of this claim limitation, Applicant respectfully points to its Specification at page 12, lines 18-23, through page 13, lines 1-2, where “[f]or each currently serviced call having being in hand-off with a number of forward links that exceeds a hand-off limit, e.g., five-way or six-way handoff, *one or more of the weakest forward links for these calls are terminated* (step 208). Limited hand-off operations then continue (step 210) until the Walsh code reserve requirement is met (step 212). When the Walsh code reserve requirement is met, normal hand-off operations resume (step 214).” (*see also* Figure 2). Generally, for additional links to be terminated, repetition is called for.

With respect to Independent Claims 21 and 22, the aspect of Applicant's invention is described in an algorithmic fashion, which is submitted as "expressly, implicitly, or inherently supported in its originally filed disclosure." For example, Applicant's Abstract recites "with hand-off operations according to the present invention, *each cell or sector participating in hand-off for a mobile terminal* uses a unique Walsh code for covering its forward link signals. When the number of Walsh codes available for servicing new calls is reduced so that it meets or exceeds a Walsh code availability threshold, *the number of cells and sectors that may participate in hand-off is reduced from the maximum number*. In the number of participating cells/sectors results in release or non-use of some Walsh codes. In subsequent operations when *sufficient Walsh codes are available for servicing hand-off operations*, a greater number, up to the maximum number of cells and sectors may again participate in hand-off of the mobile terminal." (Abstract; *see also* Specification at p. 5, *ll.* 14-19) (emphasis added).

With respect to a predetermined lesser number of soft handoff links S, "a Walsh code availability threshold had previously been met, five-way and six-way hand-off are prohibited and only four-way hand-off is serviced." (Specification at p. 12, *ll.* 1-2).

Applicant respectfully submits that Applicant's specification reflects that it "was in possession of the invention, and that the invention, in that context, is whatever is now claimed."

## **2. Rejection under 35 U.S.C. § 103(a)**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 2142, p. 2100-134 (Rev. 3, May 2005).

**(a) Claims 4, 5, 8, 10-12 and 21 had been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,160,798 to Reed et al. (“Reed”).**

Reed describes resource management in a radiotelephone network that is accomplished by load balancing. When it is determined that the network has become out of balance and that too many resources are being used at a particular cell site, the network causes handoff threshold parameters to be changed thereby causing mobile units to change the cell sites with which they are in soft handoff. This reduces the number of mobiles being supported by the overloaded cell site but does not affect the maximum number of cell sites to which each mobile can be in soft handoff. That is, Reed does not reduce the number of cell sites or sectors, but instead replaces them with less resource burdened sites or sectors.

Under Reed, when the number of available user spreading codes fall below the threshold, “the process selects a subscriber unit having an established soft handoff link with *a second base station . . .*” (Reed Col. 7:10-15) (emphasis added). “Once the subscriber unit has been selected, the process *then increases reporting thresholds, such as  $T_{drop}$ , in the selected subscriber unit to increase the likelihood that . . .* the soft handoff linked with the resource limited base station will be eliminated.” (Reed Col. 7:29-36) (emphasis added). That is, Reed encourages the mobile to transfer its soft handoff connection from a resource limited base station to other soft handoff links of another base station. (See Reed Col. 8:14-36). The process of Reed recites substantiating a base station’s resources with other base stations.

The Office Action, however, improperly relies upon Applicant’s Specification for the motivation to modify Reed to achieve its claimed invention, in that “it would have been obvious to one skilled in the art to repeat the step of terminating the weakest handoff link, in order to continue to increase the number of available spreading codes by eliminating the weaker links.” (Office Action at p. 4). That is, “after the fact, therefore because of the fact” or a form of *post hoc ergo proctor hoc* where obviousness had been improperly based upon the recited claim limitations.

The Federal Circuit has noted the impermissibility of such practices, in that “rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to *use the claimed invention itself as a blueprint* for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” As a result, the Federal Circuit “requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in

the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (citations omitted). In this manner,

Applicant’s Claim 8 recites, *inter alia*, a “method for managing Walsh Codes in a Code Division Multiple Access (CDMA) cellular wireless communication system, the method comprises: assigning a plurality of Walsh Codes to each of a plurality of serviced mobile terminals, wherein each of a plurality of Walsh Codes servicing a mobile terminal corresponds to respective soft handoff link transmissions and each of the plurality of Walsh codes is used by each cell or sector participating in hand-off for the serviced mobile terminals for covering its soft handoff link transmissions; . . . and limiting the number of soft handoff links that can be employed for each of the plurality of mobile terminals to thereby limit the number of Walsh Codes being employed by: . . . reducing the number of cell sectors or cell sites to limit the number of soft handoff links that can be employed for hand-off, and repeating the terminating of the weakest soft handoff link for at least some of the plurality of serviced mobile terminals.” (emphasis added).

Further, Applicant’s new Claim 21 recites, *inter alia*, a “method for managing Walsh Codes in a wireless communications network comprising the steps of: determining when a given communications cell sector or cell site has fewer than N unused Walsh Codes, where N is a pre-set integer, thereby blocking new call setups or new hand-offs by the given cell sector or cell site; . . . and reducing the number of cell sectors or cell sites M by one and repeat the steps of determining the weakest soft handoff link and causing that link to be dropped.” (emphasis added).

Accordingly, Applicant respectfully submits that a *prima facie* case has not been established in that Reed does not teach or suggest all the claim limitations as set out in the method of Applicant’s Independent Claim 21 and Independent Claim 8. Also, Applicant respectfully submits that there is no suggestion or motivation, either in Reed or in the knowledge generally available to one of ordinary skill in the art, to modify the hand-off accelerant of Reed to achieve Applicant’s claimed invention as set out in Claims 4 and 5 that depend directly or indirectly from Independent Claim 21, and as set out in Claims 10-12 that depend directly or indirectly from Independent Claim 8.

**(b) Claims 16, 17, 20, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Reed in view of U.S. Publication No. 2005/0221828 to Wakuta et al. (“Wakuta”).**

Wakuta relates to a “method of handing off a mobile station in a mobile communication system including first and second wireless base stations, comprising the steps of: (a) *varying a handoff threshold which is set in the mobile station*, according to quality of a wireless link between the mobile station and

the first wireless base station which currently controls the mobile station; and (b) handing off the mobile station from the first wireless base station to the second wireless base station, based on the handoff threshold.” (Wakuta ¶ 0022) (emphasis added). That is, Wakuta varies the handoff threshold in each of the mobile stations. (Wakuta, ¶ 0057). Wakuta does not, *inter alia*, reduce the number of cell sites or sectors, but simply recites thresholds for mobile station handoff.

Applicant’s Claim 22 recites, *inter alia*, a “base station controller that supports Code Division Multiple Access (CDMA) operations, the base station controller comprises: . . . a plurality of software instructions that are executed by the processor, the plurality of software instructions including: . . . software instructions that, upon execution by the processor, cause the base station controller to, in the event that the preceding step fails to increase the number of unused Walsh Codes and the number of cell sectors or cell sites M, where M is greater than a predetermined lesser number of soft handoff links S, where S is an integer, reduce the number of cell sectors or cell sites M by one and repeat the steps of determining the weakest soft handoff link and causing that link to be dropped.” (emphasis added).

Accordingly, Applicant respectfully submits that there would be no suggestion or motivation, either in the handoff accelerant of Reed or the mobile station threshold device of Wakuta to achieve Applicant’s claimed invention as set out in its Independent Claim 22, or in Claims 16, 17 and 20 that depend therefrom.

### **3. Conclusion**

As a result of the foregoing, the Applicant respectfully submits that Claims 4, 5, 8, 10-12, 16, 17, 20 and new Claims 21 and 22, are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [ksmith@texaspatents.com](mailto:ksmith@texaspatents.com).

**Appl. No. 10/035,846**  
**Response to Official Action dated January 29, 2007**  
**Reply to Office Action mailed October 27, 2006**

**Docket No. 13166RRUS01U**

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (ref 13166RRUS01U). 37 CFR 1.136.

Respectfully submitted,

**Date: January 29, 2007**

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